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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,662	07/18/2000	Rufus H. Carswell	Carswell.utl	8764

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HINKLE & O'BRADOVICH, LLC  
395 SCENIC HIGHWAY  
LAWRENCEVILLE, GA 30045

EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 04/22/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/618,662

Applicant(s)

CARSWELL ET AL.

Examiner

Donald L. Champagne

Art Unit

3622

MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed with an amendment on 30 January 2004 have been fully considered but they are not persuasive. The arguments are discussed at para. 4 below.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 3-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Golden et al.
4. Golden et al. teaches (independent claims 1, 8 and 20) a system and method for issuing/managing promotions, and preventing fraudulent/abusive use of online promotions, the system comprising: a first computer, *service database 2* (col. 3 line 67) connected to a network (*online*, col. 3 line 61) and having a memory (storage for *coupon instructions 19*); at least one additional computer, *consumer's PC 3*, having a memory; and a first process that resides in the memory of the first computer (col. 3 line 59 to col. 4 line 8) to: distribute a promotion/*coupon* on the network; identify the downloading of the promotion by the at least one additional computer (col. 4 lines 46-51), and associate a first data structure, *the number of coupons to be issued*, with the promotion (col. 4 lines 60-65); allowing the at least one additional computer to download the promotion if security software residing on the at least one additional computer has not detected the first data structure more than once (col. 4 lines 6-8 and col. 5 lines 54-57), which also reads on terminating any further attempts by the at least one additional computer to download the promotion any additional times; associate a second data structure, *the consumer's PIN 50*, with the promotion and display a symbol of the data structure *a barcode of the consumer's PIN 50*, on the promotion if the promotion is printed (col. 5 lines 43-51); and communicate a copy of the second data structure to a clearinghouse that can compare the copy to the symbol on the promotion (col. 4 lines 46-51).

Art Unit: 3622

5. Applicant argues that certain words in the claims are missing from certain cited parts of the reference. US patents are granted or denied based on the technological substance of the claimed and reference inventions, not merely on the choice of words used to describe the inventions. Also, a reference is available for all that it teaches. For example, in reference to a paragraph in Golden (col. 3 line 59 to col. 4 line 8), applicant argues (bottom of p. 9) "Nowhere in that paragraph does Golden describe a method for preventing abusive use of online promotions". Lines 60-61 of that paragraph teaches *electronic certificates such as coupons*, where a *coupon* is readily understood by one of ordinary skill in the art to be a common kind of promotion. Applicant has acknowledged this at specification p. 5 lines 5-6: "the invention provides a system and method for issuing on-line promotions such as coupons" (emphasis added). Furthermore, col. 1 lines 60-61 gives as the purpose of the reference invention *to use an online certificate as a promotional means*. Col. 4 lines 6-8 of the subject paragraph, which the examiner highlighted in the copy provided to applicant, teaches that the reference invention limits the number of coupons which can be downloaded. That would be understood by one of ordinary skill in the art as a method for preventing abusive use of online promotions.
6. Golden et al. also teaches at the citations given above claims 3-6, 18 and 19.
7. Golden et al. also teaches: claim 7, where the "device" is the *coupon issuer 1*, which accomplishes the disallowing function by downloading coupon instructions (col. 4 lines 54-55); claims 9-15 and 18, where the sites of *service database 2* (col. 2 line 48, col. 3 line 67, col. 4 lines 2-3 and col. 5 lines 64-66) reads on a web site; claims 16, where *the consumer's resident software* (col. 5 line 55) reads on a cookie; and claim 17, where the "device" is the sites of *service database 2*.

### **Conclusion**

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
9. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will


Art Unit: 3622

expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 703-746-5536.
11. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.
12. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
13. Applicant may have after final arguments considered and amendments entered by filing an RCE as appropriate. It is the examiner's practice to search the specification of RCE filings for allowable matter. However, unless indicated in this or a previous Office action, examiner cannot give assurances that filing an RCE will result in an indication of allowable matter.
14. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring

Art Unit: 3622

that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

A handwritten signature in black ink, appearing to read "Donald L. Champagne", written in a cursive style.

Donald L. Champagne  
Examiner  
Art Unit 3622

21 April 2004